UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,485	07/29/2003	Vernon E. McGeorge JR.	10992445-2	7453

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EXAMINER
SAEED, USMAAN

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/629,485	MCGEORGE, VERNON E.
	Examiner	Art Unit	
	Usmaan Saeed	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 July 2003</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>29 July 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date <u>07/29/2003</u>.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-27 are pending in this office action.

Information Disclosure Statement

2.   Applicants' Information Disclosure Statement, filed on 07/29/2003 has been

received, entered and considered. See attached form PTO-1449.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ
644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 16 and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,629,098. Although the conflicting claims are not identical, they are not patentably distinct from each other because for the reason set forth hereinbelow.

Claim 1 contains all the limitations of claim 1 of the patent No. 6,629,098 except the limitations "comparing said data to a validation rule; adding an exception rule to said exception set; presenting said exception set to a user for review; accepting a corrected data input from said user; comparing said corrected data input with said predetermined validation criteria; comparing said corrected data input with said validation rule; adding said criteria exception when said corrected data input fails to compare with said predetermined validation criteria; and adding said rule exception when said corrected data input fails to compare with said validation rule." **However, it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art.** *In re Karlson,* **136 USPQ 184 (CCPA 1963). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the above limitations without changing the function of the system.**

Claim 2 contains all the limitations of claim 1 of the patent No. 6,629,098 except the limitations "presenting said exception set to a user for review; accepting a corrected data input from said user; comparing said corrected data input with said predetermined validation criteria; comparing said corrected data input with said validation rule; adding said criteria exception when said corrected data input fails to compare with said predetermined validation criteria; and adding said rule exception when said corrected data input fails to compare with said validation rule." **However, it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the above limitations without changing the function of the system.**

Claim 3 contains all the limitations of claim 1 of the patent No. 6,629,098 except the limitations "accepting a corrected data input from said user; comparing said corrected data input with said predetermined validation criteria; comparing said corrected data input with said validation rule; adding said criteria exception when said corrected data input fails to compare with said predetermined validation criteria; and adding said rule exception when said corrected data input fails to compare with said validation rule." **However, it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ**

184 (CCPA 1963). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the above limitations without changing the function of the system.

Claim 16 contains all the limitations of claim 1 of the patent No. 6,629,098 except the limitations "comparing said data with a predetermined validation criteria; comparing said data to a validation rule; adding an exception rule to said exception set; presenting said exception set to a user for review; accepting a corrected data input from said user; comparing said corrected data input with said predetermined validation criteria; comparing said corrected data input with said validation rule; adding said criteria exception when said corrected data input fails to compare with said predetermined validation criteria; and adding said rule exception when said corrected data input fails to compare with said validation rule." However, it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to omit the above limitations without changing the function of the system.

Claim 26 contains all the limitations of claim 1 of the patent No. 6,629,098 except the limitations "comparing said data to a validation rule; adding an exception rule to said exception set; presenting said exception set to a user for review; accepting a corrected

data input from said user; comparing said corrected data input with said predetermined

validation criteria; comparing said corrected data input with said validation rule; adding

said criteria exception when said corrected data input fails to compare with said

predetermined validation criteria; and adding said rule exception when said corrected

data input fails to compare with said validation rule." **However, it has been held that**

omission of an element and its function in a combination where the remaining

elements perform the same function as before involves only routine skill in the

art. In re Karlson, 136 USPQ 184 (CCPA 1963). Thus, it would have been obvious

to one of ordinary skill in the art at the time the invention was made to omit the

above limitations without changing the function of the system.

"A later patent claim is not patentably distinct from an earlier patent claim if the

later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at

896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting

because the claims at issue were obvious over claims in four prior art patents); In re

Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of

obviousness-type double patenting where a patent application claim to a genus is

anticipated by a patent claim to a species within that genus). " ELI LILLY AND

COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the

Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30,

2001).

4.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis

added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 4, 10 and 11 are rejected under 35 U.S.C. 101 as claiming the same

invention as that of claims 1-3 of prior U.S. Patent No. 6,629,098. This is a double

patenting rejection.

Claim 4 contains all the limitations of claim 1 of the patent No. 6,629,098.

Claim 10 contains all the limitations of claim 2 of the patent No. 6,629,098.

Claim 11 contains all the limitations of claim 3 of the patent No. 6,629,098.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, and 5-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Scott Ellard** (**Ellard** hereinafter) U.S. Patent No. 5,991,758 in view of **Rich et al.** (**Rich** hereinafter) U.S. Patent 6,748,554.

With respect to claim 1, 2, 16 and 26 **Ellard** teaches **"a method of validating data submitted to a database application comprising the steps of"** as validating the data in the received data record (**Ellard** Abstract line 7).

"receiving data input in response to a query presented to a user" as the master entity index system may include a master entity index (MEI) 32 that processes, updates and stores data records about one or more entities from one or more information sources 34, 36, 38 and responds to commands or queries from a plurality of operators 40, 42, 44, where the operators may be either users or information systems (**Ellard** Col 4, Lines 33-39).

"comparing said data with a predetermined validation criteria" as a system and method is also provided for retrieving records that refer to an entity characterized by a specific set of data values by comparing a predetermined number of fields within the received data record with a predetermined number of fields within the data records already in the database (**Ellard** Col 3, Lines 29-35).

"**adding a criteria exception rule to an exception set class where said data fails to meet said predetermined validation criteria, said exception identifies a data field of said data input which does not meet said validation criteria**" as The exception handling database 82 contains one or more exception handling routines that permit the master entity index system to handle data record problems. The exception handling rules within the database may have the form of "condition.fwdarw.action" processing rules (**Ellard** Col 7, Lines 56-60). If there are two data records that appear to relate to the same entity, but the sex of the entity is different for each data record, the MEI should request further review of the data records. In response to this request, an operator may determine that the data records are the same, with a incorrectly typed sex for one of the records and the operator may enter a rule into the rules database that the two data records are linked together despite the difference in the sex attribute. The exception database may have an associated database 80 (described below), which stores the actual exceptions that occur during processing of the input data records (**Ellard** Col 8, Lines 1-12).

Ellard discloses the elements of claim 1 as noted above but does not explicitly teach the step of, having "**exception set with class.**"

However, **Rich** discloses "**exception set with class**" as if no exception handler had been set by any class on the stack, the current Java program is terminated. If an exception handler had been set, then the JVM trims the stack of any classes that had not set an exception handler (after the one class that had set an exception handler), and gives the exception handler control. If the exception handler does not in fact handle the

exception, then the JVM resumes its search for a handler as outlined above. If the

exception handler does handle the exception, then program execution now continues in

the class that contained the exception-handling code. Note that since the exception has

now been handled, it is as if it had never happened (**Rich** Col 4 Lines 56-68).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teaching of the cited references because **Rich's**

teaching would have allowed **Ellard** to provide a default notification, or to enable an

authority to provide its own set of customized notifications (**Rich** Col 2, Lines 2-5) by the

use of class that contains exception set.

With respect to claims 3, 14 and 15 **Ellard** teaches **"the step of presenting said**

exception set class to a user for review" as the routine may generate a message for

the operator or may process the data using another software program. A message may

be displayed to the user in step 158. If there was not an exception handling routine in

the exception handling database, then a message is printed for the user in step 158.

The message may require the user to perform some action or may just notify the

operator of the action being taken by the MEI in response to an exception (**Ellard** Col

10, Lines 60-67).

With respect to claim 5, 17 and 18 **Ellard** teaches **"wherein said data input is**

received from a client-side application" as the master entity index system may

include a master entity index (MEI) 32 that processes, updates and stores data records

about one or more entities from one or more information sources 34, 36, 38 and

responds to commands or queries from a plurality of operators 40, 42, 44, where the

operators may be either users or information systems (**Ellard** Col 4, Lines 33-39 &

Figure 5, element 122).

With respect to claims 6-9, 11, 12, 13 and 25 **Ellard** teaches **"wherein said**

exception set class comprises a data object" as additional data sets may be

involved in the validation process, for example, a data set containing valid customer

account numbers. If the validation process fails, in step 176 an exception may be

created that indicates that invalid data is received, the exception handling method

described above may be performed, and processing of the insert new

record operation is complete (**Ellard** Col 11, Lines 22-27). **"data object comprising**

an exception set and exception set comprising a plurality of exceptions" as

In step 154, the MEI determines if there is an exception handling rule within the

exception handling database 82 for handling the anomaly, as shown in FIG. 3 As

described above, the exception handling database contains a plurality of rules for

handling various types of exceptions. If an exception handling rule is in the exception

handling database, in step 156, the MEI may perform the exception handling routine in

the database (**Ellard** Col 10, Lines 53-60).

With respect to claim 10 **Ellard** teaches **"the method of claim 9, wherein said**

data field is associated with a throwable object where said data field cannot be

validated" as additional data sets may be involved in the validation process, for

example, a data set containing valid customer account numbers. If the validation

process fails, in step 176 an exception may be created that indicates that invalid data is

received, the exception handling method described above may be performed, and

processing of the insert new record operation is complete (**Ellard** Col 11, Lines 22-27).

The data field is associated with a throwable object since the exception set contains

exceptions and the exception is specifying the data input field that contains data that

cannot be validated.

With respect to claims 19-24, **Ellard** teaches the claimed invention of **"network**

interface and a client server application" as shown in Figure 1.

6.   Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellard et**

al. (Patent No. 5,991,758).

With respect to claim 4, **Ellard** teaches **"the method of claim 3, further**

comprising the steps of accepting a corrected data input from said user,

comparing said corrected data input with said predetermined validation criteria,

comparing said corrected data input with said validation rule" as the identifying

means further comprising one or more control databases for identifying errors in the

data contained in one or more fields of the received data record in order to correct the

data in the received data record and means for matching the corrected data in the

received data record with the data records already in the database. Means for scoring

the identified matching candidates using a predetermined scoring criteria, which

measures a likelihood of a match between the received data record and the data

records in the database. (**Ellard** Col 16, Lines 1-7) (Col 4, Lines 50-56).

Ellard discloses the elements of claim 4 as noted above but does not explicitly

teach the step of, "**adding said criteria exception when said corrected data input**

fails to compare with said predetermined validation criteria, and adding said rule

exception when said corrected data input fails to compare with said validation

rule."

However, **Ellard** teaches "**adding said criteria exception when said corrected**

data input fails to compare with said predetermined validation criteria, and adding

said rule exception when said corrected data input fails to compare with said

validation rule" as if the validation process fails, in step 199 an exception may be

created that indicates that invalid data is received, the exception handling method

described above may be performed, and the processing of the update existing data

record operation is complete (**Ellard** Col 12, Lines 12-16). If there are two data records

that appear to relate to the same entity, but the sex of the entity is different for each

data record, the MEI should request further review of the data records. In response to

this request, an operator may determine that the data records are the same, with a

incorrectly typed sex for one of the records and the operator may enter a rule into the

rules database that the two data records are linked together despite the difference in the

sex attribute. The exception database may have an associated database 80 (described

below), which stores the actual exceptions that occur during processing of the input

data records (**Ellard** Col 8, Lines 1-12). Examiner interprets the update data as

corrected data.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine the teachings of the cited reference to implement a

method of adding an exception rule because it aids in handling a similar exception in

future.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by **Ellard et al.**

(U.S. Patent No. 5,991,758).

With respect to claim 27, **Ellard** teaches a system for validating data input,

comprising:

"client-side terminal for presenting a data entry form to a user" as the

master entity index system may include a master entity index (MEI) 32 that processes,

updates and stores data records about one or more entities from one or more

information sources 34, 36, 38 and responds to commands or queries from a plurality of

operators 40, 42, 44, where the operators may be either users or information systems

(**Ellard** Col 4, Lines 33-39).

"database server for receiving a data entry record from said client-side

terminal and incorporating it into database where certain pre-determined

validation criteria are met" as the data store 54 may include an entity database 56,

one or more control databases 58, and an exception occurrence database. The entity

database may store the data from the data records as specified above from the one or

more information sources and may separately store links between one or more data

records when those data records contain information about the same entity (**Ellard** Col

5, Lines 29-35).

Conclusion

8.   The prior art made of record and not replied upon is considered pertinent to

applicant's disclosure is listed on 892 form.

Contact Information

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Usmaan Saeed whose telephone number is (571)272-

4046. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain Alam can be reached on (571)272-3978. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Usmaan Saeed
Patent Examiner
Art Unit: 2166

MOHAMMAD ALI
PRIMARY EXAMINER

Hosain Alam   US
Supervisor   January 30, 2006